

REMARKS

Applicants respectfully request reconsideration of the present U.S. Patent application as amended herein. No claims have been amended or added. Please cancel any designation or reference to claim 28. Please cancel claims 32-34 without prejudice. Thus, claims 1-27 and 29-31 are pending.

Objection to the Drawings

The drawings were objected to as failing to comply with 37 C.F.R. § 1.84(p)(5) for including the reference numeral 272, which is not mentioned in the description of Figure 2C. The specification has been amended to include the reference numeral 272 in the paragraph at page 15, lines 4-10. No new matter has been added. Therefore, Applicants request that the objection to the drawings be withdrawn.

Objection to the Specification

The specification was objected to for an informality. Specifically, on page 20, line 12, reference numeral "440" should be --540--. The suggested amendment has been made to the specification in the paragraph at page 20, lines 6-13. Therefore, Applicants request that the objection to the specification be withdrawn.

Objection to the Claims

Claim 28 was objected to because there is no claim 28. Applicants inadvertently skipped claim 28 in the originally filed application. Please cancel any designation or reference to claim 28. Applicants request that the objection to the claims be withdrawn.

Application/Control No. 09/410,494
Atty. Docket No. 074451.P107

-3-

Examiner Young N. Won
Art Unit 2155

Claim Rejections - 35 U.S.C. § 102(e)

Claims 1-8, 12-20, 24-27 and 29-34 were rejected as being anticipated by U.S. Patent No. 5,848,410 issued to Walls, et al. (*Walls*). Claims 32-34 have been canceled without prejudice. Therefore, the rejection of claims 32-34 as being anticipated by Walls is moot. For at least the reasons set forth below, Applicants submit that claims 1-8, 12-20, 24-27 and 29-31 are not anticipated by *Walls*.

Claim 1 recites:

generating, automatically with an electronic device, a first search request in response to an original search request, the first search request to cause a search to be performed on electronic documents unconsciously captured by a local network device, the search of the electronic documents unconsciously captured to be performed according to search parameters of the original search request; and

generating, automatically with the electronic device, a second search request in response to the original search request, the second search request to cause a search to be performed on electronic documents available via a network portal of an external network according to the search parameters of the original search request.

Thus, Applicants claim two searches in response to a single, original search request. The first search is of unconsciously captured documents on a local network device and the second search is performed via a network portal of an external network. Claim 13 is directed to a machine readable medium and recites similar limitations.

Walls discloses a system and method for indexing and searching a large database, such as the World Wide Web. See Abstract. *Walls* discloses indexing a file system. See col. 11, lines 25-29. The indexing can indicate whether an indexed document is "remote" or "local." See col. 19, lines 5-10. However, *Walls* does not disclose generating two search requests, one for unconsciously captured documents on a local network device and another for a network portal of an external network

The Office Action indicates *Walls* discloses a first search at col. 11, lines 25-39 and a second search at col. 26, lines 25-26. The cited passage in column 11 refers to indexing files and the cited passage in column 26 *claims* indexing files. Applicants submit that, even *if* the indexing of *Walls* corresponds to the search requests of claims 1 and 13, *the two cited passages refer to the same indexing operation and not to two separate indexing operations*. Therefore, *Walls* does not anticipate the invention as claimed in claim 1 and 13.

Claims 2-8 and 12 depend from claim 1. Claims 14-20 and 24 depend from claim 13. Because dependent claims include the limitations of the claims from which they depend, Applicants submit that claims 2-8, 12, 14-20 and 24 are not anticipated by *Walls* for at least the reasons set forth above.

Claim 25 recites:

a device to automatically capture electronic documents from the network; and

an application to search the captured electronic documents in response to a search request, wherein the application also generates an external document search request in response to the search request, the external document search request to generate a search of electronic documents from an external network.

Thus, Applicants claim a device to automatically capture documents and an application to search the captured documents as well as generate a search request for external documents. Claims 26-31 depend from claim 25.

As described above, *Walls* does not disclose multiple search requests for both local and external network documents. Therefore, *Walls* does not anticipate the invention as claimed in claims 25-31.

Claim Rejections - 35 U.S.C. § 103(a)

Claims 9 and 21 were rejected as being unpatentable over *Walls* in view of U.S. Patent No. 6,088,675 issued to MacKenty, et al. (*MacKenty*). For at least the reasons set forth below, Applicants submit that claims 9 and 21 are not rendered obvious by *Walls* and *MacKenty*.

Claim 9 depends from claim 7, which depends from claim 1 and adds the limitation that a search report is generated using XML. Similarly, claim 21 depends from claim 19, which depends from claim 13 and adds the limitation that a search report is generated using XML.

MacKenty discloses converting speech and non-speech sounds to SGML/XML documents. See Abstract. Thus, *MacKenty* does not teach *search reports* being generated using XML. Furthermore, even if *MacKenty* did disclose generating search reports using XML, *MacKenty* does not cure the deficiencies of *Walls*. Therefore, no combination of *Walls* and *MacKenty* teaches or suggests the invention as claimed in claims 9 and 21.

Claims 10, 11, 22 and 23 were rejected as being unpatentable over *Walls* in view of U.S. Patent No. 5,913,040 issued to Rakavy, et al. (*Rakavy*). For at least the reasons set forth below, Applicants submit that claims 10, 11, 22 and 23 are not rendered obvious by *Walls* and *Rakavy*.

Claims 10 and 11 depend from claim 7, which depends from claim 1 and add limitations related to advertising in a search report. Claims 22 and 23 depend from claim 19, which depends from claim 13 and add limitations related to advertising in a search report.

Rakavy discloses monitoring a user's communication link and providing advertising to the user based on utilization of the communication link. See Abstract. However, *Rakavy* does not teach or suggest including the advertising in a search report as claimed in claims 10, 11, 22 and 23. Furthermore, *Rakavy* does not cure the deficiencies of *Walls*. Therefore, no combination of *Rakavy* and *Walls* teaches or suggests the invention as claimed in claims 10, 11, 22 and 23.


Conclusion

For at least the foregoing reasons, Applicants submit that the rejections have been overcome. Therefore, claims 1-27 and 29-31 are in condition for allowance and such action is earnestly solicited. The Examiner is respectfully requested to contact the undersigned by telephone if such contact would further the examination of the present application.

Please charge any shortages and credit any overcharges to our Deposit Account number 02-2666.

Respectfully submitted,
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN, LLP

Date: JUNE 6, 2002


Paul A. Mendonça
Attorney for Applicant
Reg. No. 42,879

12400 Wilshire Boulevard
Seventh Floor
Los Angeles, CA 90025-1026
(503) 684-6200

Application/Control No. 09/410,494
Atty. Docket No. 074451.P107

Examiner Young N. Won
Art Unit 2155

MARKED VERSION OF THE AMENDMENTSIN THE SPECIFICATION

In the paragraph on page 15, lines 4-10:

During the document storage process, the FMA creates appropriate directories, moves the document to the appropriate directory and updates the master list. The metadata file of the document to be stored is accessed and information from its "Capture data" field is retrieved, 270. If the document's "Capture date" or even the metadata file does not exist, 272, then the current system time is obtained and used as the document's "Capture date," 274. If, however, the document's "Capture date" does exist, 272, the system determines whether an appropriately named directory exists.

In the paragraph on page 20, lines 6-13:

The portal appliance waits for a predetermined time for retrieving information, 510. Predetermined content is retrieved in response to a request at the predetermined time, 520. The content can be retrieved by the portal appliance "pulling" the content, for example, in the form of one or more HTTP requests initiated by the portal appliance. The content can also be "pushed" by an external portal to the portal appliance, for example, with an HTTP or FTP operation. The content is captured by the portal appliance, 530. The content is archived by, for example, the FMA, 540 [440]. If additional retrievals are scheduled, 550, the process is repeated.